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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/669,056	06/24/96	NACHMAN	B INFINITY-3.0

EXAMINER: LEE,C

ART UNIT: 2616 | PAPER NUMBER: 4

DATE MAILED: 05/19/97

26M2/0519

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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☑ Responsive to communication(s) filed on 8-23-96

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three(3) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☑ Claim(s) 1-12 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☑ Claim(s) 1-12 is/are rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☑ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.
☐ received in Application No. (Series Code/Serial Number) _____.
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☑ Notice of Reference Cited, PTO-892
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
☐ Interview Summary, PTO-413
☑ Notice of Draftperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

* U.S. GPO: 1996-404-496/40517

1. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 2 and 8-12 are rejected under the judicially created doctrine of **double patenting** over claims 1, 8, 13, and 16 of U. S. Patent No. 5,530,558 since the claim, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

a) Application claim 1 and patent claim 1 both claim the same subject matter, except for the "manually operatable switch member" of the "second switch means" and the operation of the

second switching means being responsive to manual operation of the "manually operatable switching member" of patent claim 1.

b) Application claim 2 and patent claim 16 both claim the same subject matter, except for the limitations stated for part a) above.

c) Application claim 8, depending upon claim 1, and patent claim 8, depending upon claim 1, both claim the same subject matter.

d) Application claim 9, depending upon claim 1, and patent dependent claim 13 both claim the same subject matter.

e) Application claim 10, depending upon claim 1, claims a storage device, in the interface device, for storing data for later use and transmission, which is disclosed in the patent.

f) Application claim 11, depending upon claim 1, claims a send/receive communications circuit coupled to the interface device to receive/transmit digital signals, which is disclosed in the patent.

g) Application claim 12, depending upon claim 1, claims an optical scanning device in the facsimile machine to converted generated analog signals to digital signals, and means for coupling the digital signals to the pc, which is disclosed in the patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which

matured into a patent. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claim 3 is rejected under **35 U.S.C. 101** as claiming the same invention as that of claim 23 of prior U.S. Patent No. 5,530,558. This is a **double patenting** rejection.

Application claim 3 and patent claim 23 claim the same subject matter of each other.

5. Claims 4-7 are rejected under the judicially created doctrine of **obviousness-type double patenting** as being unpatentable over claims 28-31 of U.S. patent no. 5,530,558 in view of Horton et al. (U.S. Patent No. 4,821,312).

Claim 4 recite all limitations of patent claim 28 and in addition the step of operating a keypad of the facsimile machine

to generate selected tones so that operation of the first switching assembly is responsive to the generated tones.

Horton et al. discloses a switch (13) for selectively connecting data or telecommunication devices such that switch switches from a first position to a second position when a tone detector in the switch detects selected tone signals generated by operating a key pad (see Fig. 2 and col. 4, lines 2-15).

It would have been obvious to one of ordinary skill in the art to replace the manual switching procedures of the application claim 4 with the procedure of switching from a first position to a second position of the switch responsive to detection of tone signals generated from the keypad of the facsimile machine, as taught by the Horton et al., to enable the switching without an operator at the switch as suggested by Horton et al. (col. 2, lines 15-21).

Application claim 5 is rejected as claiming the same limitation as that of patent claim 29.

Application claim 6 recite all limitations of patent claim 30 and in addition the step of transmitting selected tones to the facsimile machine so that coupling of the facsimile machine and computer is responsive to the generated tones.

As discussed for claim 4 above, the switch (13) of Horton et al. switches to couple separate devices (including a facsimile machine or a computer) responsive to tone signals of generated from a keypad of a communication device. Horton further

discloses transmitting the tone signal from one communication device to another communication device.

It would have been obvious to one of ordinary skill in the art to transmit selected tones from one communication device (computer) to another communication device (facsimile machine) of application claim 6 to activate operation of a switch as taught by Horton et al., and to apply the idea of Horton et al. to switch from one position to another to couple the computer and the facsimile device responsive to generation of the selected tone signal(s) because it enable the coupling without an operator as suggested by Horton et al.

Application claim 7 is rejected as claiming the same subject matter as that of patent claim 31.

6. The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. 1.78(d).

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nakamura et al. (U.S. 5,608,546) discloses a data communication apparatus in which a facsimile machine is used as an input and output apparatus of a personal computer.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee at telephone number (703) 305-4867, art unit fax no. (703) 308-5397, or supervisory patent examiner Edward Coles at (703) 305-4712. The group receptionist can be reached at (703) 305-3900.

C. Lee
May 6, 1997